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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

40699.0001

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on August 4, 2005

Signature

Typed or printed name

Rachel Watt

Application Number

10/825,989

Filed

April 16, 2004

First Named Inventor

James BOTELHO

Art Unit

3747

Examiner

Noah P. Kamen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 39,336☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

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Typed or printed name

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Telephone number

August 4, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Attorney Docket No.: 40699.0001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit : 3747
Examiner : Noah P. Kamen

Applicant	:	James BOTELHO
Serial No.	:	10/825,989
Filing Date	:	April 16, 2004
Title	:	MOTORCYCLE ENGINE

**APPLICANT'S REASONS FOR
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Pre-Appeal Brief Request for Review is being requested because Applicant believes that the Examiner has not made a prima facie case for obviousness.

As set forth in the Response filed by the Applicant on April 14, 2005, on pages 2 and 3, modifying the engine disclosed in the primary reference (Itoh) as suggested by the Examiner would destroy the intended function of the engine.

Also, there is no teaching or suggestion in the Itoh reference to modify the design to produce the invention as claimed by the Applicant.

Serial No.: 10/825,989

Attorney Docket No.: 40699.0001

In the Office Action mailed on December 2, 2004, the Examiner has taken a background statement from the subject application to provide the "teaching" to modify Itoh as suggested by the Examiner.

Neither the statement quoted by the Examiner nor Itoh teaches the unique engine as claimed, and therefore it is respectfully submitted that the rejection is unsupported and improper and should be withdrawn.

Respectfully submitted,
HODGSON RUSS LLP
Attorneys for Applicant(s)

By 
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Date: August 4, 2005

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